



REPLY BRIEF
U.S. Application No. 10/020,136
Attorney Docket No.: 53326.000012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:)	Attorney Docket No. 53326.000012
)	
Stephen W. Comiskey et al.)	Confirmation No. 9781
)	
Application Number: 10/020,136)	TC/A.U.: 1734
)	
Filed: December 18, 2001)	Examiner: Sue A. Purvis
)	
)	Customer No. 21967
For: REFLECTED LIGHT GLARE MINIMIZATION FOR		
ATHLETIC CONTEST PARTICIPANTS WHILE		
PROVIDING A NON-VERBAL COMMUNICATION		

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REPLY BRIEF

Sir:

This is Appellants' Reply Brief responsive to the Examiner's Answer mailed February 6, 2006, in connection with the above-captioned patent application. Appellants present this brief to clarify points raised by the Examiner in the Examiner's Answer.

Appellants believe that there is no fee required for the submission of this Reply Brief. However, the Commissioner is hereby authorized to charge Deposit Account No. 50-0206, if deemed necessary.

I. The Examiner's Proposed Combination Relies Solely on Improper Hindsight

Claims 21-24 and 31-34 are currently rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 4,719,909 to Micchia *et al* ("Micchia") in view of U.S. Patent No. 1,300,592 to Essig ("Essig"). Claims 26-30 and 36-40 are currently rejected under 35 U.S.C. § 103(a) over Micchia in view of Essig and further in view of US Patent No. 5,470,351 to Ross *et al* ("Ross"). Claims 25 and 35 are currently rejected under 35 U.S.C. § 103(a) over Micchia in view of Essig and further in view of Ross and US Patent No. 4,522,864 to Humason *et al* ("Humason").

The references relied upon by the Office Action are improperly combined. On pages 9-10, the Examiner states that "it would have been obvious to one having ordinary skill in the art at the time of the invention ... to further decorate the applied patch." This is a clear example of improper hindsight. More specifically, the Examiner has yet to establish why one of ordinary skill in the art would want to modify the uniform black eye patch of Micchia to include a decoration as alleged by the Office Action, when the disclosure of Essig fails to provide any teaching to do so. The Examiner is clearly picking and choosing aspects of the applied references to somehow forge together an unsupported obviousness rejection. The Examiner's reliance on Essig is misplaced. Essig is directed to an ornamental tattoo filled with perfume to be worn on the body where perfume is released as body temperature rises. The Examiner asserts that "Essig teaches the desire for a decal which includes decorative or communicative." The Examiner comes to this conclusion without relying on the disclosure of Essig. One of ordinary skill in the art would recognize that Essig discloses a decal containing perfume applied to a body as a tattoo configured to release the perfume as the wearer's body temperature rises. Only

through improper hindsight could one combine the uniform black eye patch of Micchia with the perfumed released tattoo of Essig to somehow result in Applicant's invention.

The Examiner improperly states that both Micchia and Essig are drawn to the same problem of providing decal which is used on the body. *See* page 14 of Examiner's Answer. Rather, Micchia is directed to a uniform black eye patch and Essig is directed to a perfume released body tattoo. Applicants submit that an eye patch and a perfume released body tattoo are *not* drawn to the same problem. The eye patch of Micchia is concerned with light glare, usually in sporting events. The ornamental body tattoo is concerned with the ability to release perfume when body temperature rises. The Examiner further alleges that "by providing the Micchia decal with ornamental or communicative features... the perceived problem is overcome." The Examiner has failed to even identify any perceived problem in Micchia and how a decorative butterfly body tattoo can solve any problem in Micchia.

II. The Examiner Improperly Interprets Claim Limitations

The Examiner's combination of Micchia and Essig completely fails to render the claimed inventions obvious. The Examiner's reliance on examples of a heart, eagle and dove as well as the different ornamental butterflies is a clear indication of the Examiner's improper interpretation of the claim language. *See* pages 11-12 of Examiner's Answer. The Examiner's position is that anything decorative (even a circle) - whether intentional or not - will inevitably provide communication. *Id.* This interpretation of the claim language is overly broad. The Examiner's interpretation improperly renders the claim limitation reciting "a shape formed within the exterior surface, wherein the shape has a color contrasting to the non-reflective color and is

configured to provide communication” meaningless. Each claim term has meaning and cannot be interpreted to be devoid of any meaning.

By ignoring positively recited limitations, the Examiner has improperly construed the claims and applied references that fail to render the claimed inventions obvious.

III. The Examiner’s Proposed Combinations are Fundamentally Flawed

The Examiner asserts that “when combining these teachings, it would have been obvious to one having ordinary skill in the art at the time of the invention ... to further decorate the applied patch.” See pages 11-10 of Examiner’s Answer. The Examiner’s sole reason for modifying Micchia in view of Essig is to “decorate the applied patch.” Missing from this analysis is any indication why one of ordinary skill in the art would want to modify the uniform eye black of Micchia. In addition, what is fundamentally lacking in this analysis is any indication that the admittedly missing features of Micchia directed to “a shape formed within the exterior surface, wherein the shape has a color contrasting to the non-reflective color and is configured to provide communication” is a problem that needs to be solved or could be solved by the ornamental butterfly perfume tattoo of Essig.

When a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight

looking back at the time of the invention. Because such a proper motivation to combine is missing, the combinations are improper and the rejections should be overturned.

Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz*, 234 F.3d at 664 (“[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.”).

If the approach taken by this Examiner were adopted, in almost every instance, some reason for a modifying a reference could be created by the Examiner unrelated to any actual problem recognized in the art. It is the requirement that the motivation to solve a recognized problem be from the teachings of the art that keeps the application process honest to the goal of avoiding hindsight reconstruction. Indeed, the very key aspect in determining obviousness should be that there is a clear nexus between the teachings in the art as to the deficiencies in a particular way of doing things and a solution provided by the supplemental references.

In addition, even if the references could be combined as proposed by the Examiner, the resulting combination would nevertheless fail to render the claim inventions obvious.

IV. The Examiner Has Failed To Meet The Burden Of Proof

Under U.S. law, an inventor is entitled to a patent for any invention that is new, useful, and non-obvious. 35 U.S.C. §§ 101-103. The Examiner’s Answer has not presented a *prima facie* case of non-obviousness by which to deny a patent to Appellants. Rather than providing

statements of motivation as taught by the references, the Examiner lists selective features without providing any reasoning as to why one of ordinary skill in the art would have been motivated to combine three disparate references. The Examiner summarily concludes that the claim limitations are met without ever explaining why one of ordinary skill in the art would (1) combine the disparate references and (2) how the resulting combination meets the claimed inventions. Even if the references could be combined as suggested by the Examiner, the resulting combination would nevertheless fail to teach the combination of claim limitations recited by Appellants.

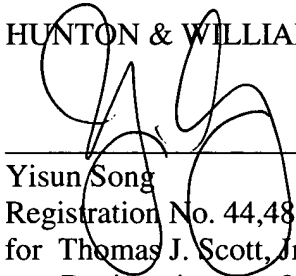
CONCLUSION

For at least the foregoing reasons, the rejections of claims 21-40 should be reversed.

Respectfully submitted,

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